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Date of Signature and Deposit: December 29, 2006

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Thomas P. Zwaka
James A. Thomson

Date: December 29, 2006

Serial No.: 10/774,122

Group Art Unit: 1633

Filed: 02/06/2004

Examiner: Maria Marvich

Title: DIRECTED GENETIC MODIFICATIONS
OF HUMAN STEM CELLS

File No.: 960296.99021

Confirmation No.: 8384

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In an Office Action mailed October 6, 2006, the Examiner in charge of the above-noted application imposed a requirement for restriction dividing the claims into two groups, which in the Examiner's opinion are not related.

In response, applicants provisionally elect Group I, drawn to Claims 1-4, 7-10, 12 and 13. This election is made with traverse and without prejudice to the eventual filing of a divisional application. The restriction is traversed on the grounds that the subject matter of Groups I and II, relating to targeted modifications in human embryonic stem cells is inextricably linked. Specifically, the claims in Groups I (method for targeted modifications) and II (human embryonic stem cells in culture having targeted modifications introduced into their genome by the method of Group I) are related because they overlap in scope. Thus, both groups should be examined together for the sake of efficiency.

Applicants believe that a proper search for one group of claims directed to a method for specifically modifying a gene within the genome of a human embryonic stem cell would

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inevitably overlap with that for the other. Thus, the results for one should bring to light the art relevant to the claims of the other group. Applicants do not believe that a burden exists for searching more than one of the patentably related group.

Applicants also wish to note that procedurally restriction requirements are optional in all cases (*see* MPEP § 803). If the search and examination of a claim set can be made without serious burden, the Examiner must examine the claims on the merits, even though they may be arguably directed at distinct or independent inventions (*Id.*). In the present application, and as described hereinabove, it is respectfully submitted that claims in Groups I-II can be examined together without serious burden on the Office.

Applicants also submit that the fees due in connection with filing a divisional patent application and for prosecution and maintaining a plurality of patents would place an undue burden on applicants. It is submitted that for the convenience of the Patent Office and applicants, applicants are best served by considering all of the claims in a single patent application and not several separate patent applications.

For these reasons, applicants respectfully request the restriction requirement on Groups I-II be reconsidered and withdrawn. Wherefore examination on the merits is respectfully requested.

Fees

A petition for a two-month extension of time accompanies this response so that it will be deemed to have been timely filed.

No other extension of time is believed due, but should any additional extension be due, in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the extension fee to Deposit Account No. 17-0055. No additional fees are believed due; however, if any fees are due, in this or any

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Subsequent response, please charge Deposit Account 17-0055.

Respectfully submitted,



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